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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,049	10/30/2000	William J. Flanagan	ET00-007CIP	8546
7590	01/05/2006		EXAMINER MEINECKE DIAZ, SUSANNA M	
Maureen Stretch 26 Charles Street Natick, MA 01760			ART UNIT 3623	PAPER NUMBER
DATE MAILED: 01/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/702,049

**Applicant(s)**

FLANAGAN ET AL.

**Examiner**

Susanna M. Diaz

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This final Office action is responsive to Applicant's response file December 13, 2005.

No claims have been amended.

Claims 2-57 remain pending.

2. The previous rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph are withdrawn in response to Applicant's arguments.

### ***Response to Arguments***

3. Applicant's arguments filed December 13, 2005 regarding priority and the art rejection have been fully considered but they are not persuasive.

Applicant argues that all claims in the instant application deserve priority back to the filing date of the parent applications (i.e., to November 16, 1998) because the term "dynamic contracts manager" has support in the parent applications. Applicant cites excerpts from both the specification of the instant application as well as the specification of U.S. Patent No. 6,141,653 (pages 2-3 of Applicant's response). However, in none of these excerpts is the phrase "dynamic contracts manager" recited. The Examiner would have to guess which, if any, content in the parent applications is equivalent to this phrase. The Applicant has not set forth a clear-cut example of support for the "dynamic contracts manager" in the parent applications such that the Examiner can with complete surety be convinced that the Applicant clearly envisioned and expressly described

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inclusion of a "dynamic contracts manager" as part of their invention at the time of filing of the parent applications. Furthermore, the Applicant filed the instant application as a Continuation-in-Part application, thereby supporting the Examiner's understanding that the claimed invention comprises subject matter not expressly or implicitly disclosed in the parent applications. It is respectfully submitted that the Applicant amend the claims to be limited to language expressly recited in the parent applications if the priority date of the parent applications is desired.

Regarding the art rejection, Applicant's arguments center around the assertion that INSS is a negotiation support tool that only simulates negotiations as opposed to actively carrying out an actual negotiation (pages 5-9 of Applicant's response). However, even if INSS is accepted as merely a simulation tool, if it performs the same functionality recited in the claimed invention, then INSS does indeed anticipate the claimed invention (as maintained by the Examiner).

Applicant further argues, "The negotiation support functions of INSS do not process a negotiation, either -- they do not analyze terms to understand their purpose. What negotiation support does is analyze the ratings or preference values the users give to the simulation terms to determine whether a particular set of mock terms is a Pareto-optimal agreement for both parties..." (Page 7 of Applicant's response) The Examiner respectfully submits that INSS must be capable of some sort of analysis to understand the purpose of terms to even generate a Pareto-optimal agreement for both parties. In other words, INSS must identify which terms and inputs relate to which party

and are significant to the Pareto-optimal analysis in order to generate meaningful results.

Applicant argues, "The INSS simulation model and negotiation support system does not recognize changes in the terms and indicate those changes to the users. All it does is calculate and display the ratings which result from the simulation negotiation rounds" (Page 8 of Applicant's response) Again, the fact that INSS knows which data to use for which calculations and that fact that it can follow the history of negotiations to plug in the correct data to the respective calculations means that INSS at some level recognizes changes in the terms and indicates those changes to the users. The claim language is very broad and does not specify any particular methodology used to recognize the changes in the terms, for example, and therefore, the Examiner maintains that INSS fully anticipates the claimed invention for the reasons set forth in the art rejection.

#### ***Priority***

4. This application was filed on October 30, 2000 as a continuation-in-part of various applications filed on November 16, 1998. It has been determined that all pending claims contain some continuation-in-part subject matter (i.e., subject matter that was not disclosed in the parent applications). For example, the recited "dynamic contracts manager" is not disclosed in the parent applications. Therefore, claims 2-57 are granted a priority date of October 30, 2000 for purposes of applying prior art.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2-57 are rejected under 35 U.S.C. 102(b) as being anticipated by INSS, as disclosed in the packet of information cited by Applicant as "INSS Negotiation Protocol" (dated September 1, 1998, listed on page 3 of the IDS stamped as received on January 13, 2005).

INSS discloses an apparatus for iterative development negotiations, comprising:

[Claim 2] a dynamic contracts manager for supplying an initial set of terms for use by a user, the terms specifying an item to be developed (Pages 6 and 8 -- Setting up the details of a negotiation, including the product or service to be negotiated, or developed, as well as the terms subject to negotiation is required); and

a multivariate negotiations system including storage space and negotiations software (Page 1 -- "INSS is a Web-based negotiation support system"; Pages 10-11, 15 -- A history of offers and messages may be accessed; therefore, offer and message information must be stored, esp. since it is used to generate a graph of the respective histories), such negotiations software executing in a processor and including an automated negotiations engine for analyzing terms, the analysis of terms comprising understanding the purpose of the terms, formatting the terms according to the purpose, and placing them into user supplied context for use by a user (Pages 2, 8-13 -- The fact

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that the offer history data is maintained, graphed, and used by the negotiation software to determine if an optimal agreement has been reached or suggest a Pareto-optimal agreement for both parties is indicative of the fact that INSS itself analyzes and understands the negotiation terms), the automated negotiations engine being responsive to a destination terminal for a first user communicating with the multivariate negotiations system, the destination terminal including software for sending and receiving terms along a communications path which flows through the multivariate negotiations system, the automated negotiations engine also being responsive to an initiating terminal for a second user communicating with the multivariate negotiations system, the initiating terminal including software for sending and receiving terms along a communications path which flows through the multivariate negotiations system, during iterative processing the automated negotiations engine recognizing the users at the destination terminal and the initiating terminal as negotiators and recognizing one of the users as a deciding entity (Pages 1, 6, 17 -- Registered users may participate in web-based negotiations using INSS. Even though each party can send various offers before receiving a response from the respective counterparty, INSS recognizes which party is officially waiting for a response, thereby recognizing a relative "deciding entity." See page 17, item 5 in particular), such automated negotiations engine further recognizing any changes in the terms and storing in the storage space the terms each terminal proposes, and recognizing the terminal to which proposal terms are being sent as the indicated terminal, and sending terms to the indicated terminal, the automated negotiations engine indicating any changes in the terms until a set of terms is acted

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upon in a final manner by the deciding entity (Pages 1-2, 8-13, 16, 17 -- The storage space, analysis of terms and changes thereof, and recognition of a terminal are addressed above);

[Claim 3] wherein the item to be developed comprises a product (Page 8 -- The aircraft itself is the product to be "developed," or negotiated);

[Claim 4] wherein the item to be developed comprises a service (Page 8 -- The sale of the aircraft is the service to be "developed," or negotiated);

[Claim 5] wherein the dynamic contracts manager further comprises a viewer for displaying aspects of the item as the item's development is being negotiated and performed (Pages 11-13 -- Graphs representing the history and progress of the negotiations process are displayed to each party);

[Claim 6] wherein the dynamic contracts manager further comprises a multimedia transmittal function for transmitting an item capable of being transmitted in electronic form as the item's development is being negotiated and performed (Page 1 -- "INSS is a Web-based negotiation support system"; therefore, all negotiations terms and messages related to the negotiated item are transmitted electronically);

[Claim 7] wherein the dynamic contracts manager further comprises an active template for supplying some of the initial terms (Pages 9-12 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process);

[Claim 8] wherein the active template further comprises predefined formats for designated terms (Pages 9-12 -- The tables showing the negotiated terms, e.g., price

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and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process. INSS is preprogrammed with the proper format required to display the tables as shown; therefore, INSS is programmed with predefined formats for the designated terms);

[Claim 9] wherein the predefined formats further comprise functions for activating computer programs (Pages 9-13 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process. INSS is preprogrammed with the proper format required to display the tables as shown; therefore, INSS is programmed with predefined formats for the designated terms. The data from the tables is used to create a negotiations history and generate the graphs, thereby implying that INSS's predefined formats are utilized to activate the history storage and graphing computer programs);

[Claim 10] wherein the computer programs further comprise computer programs for importing and exporting data (Pages 9-13 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process. INSS is preprogrammed with the proper format required to display the tables as shown; therefore, INSS is programmed with predefined formats for the designated terms. The data from the tables is used, or exported, to create a negotiations history and generate the graphs, i.e., by importing the data, thereby implying that INSS's predefined formats are utilized to activate the history storage and graphing computer programs);

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[Claim 11] wherein the computer programs further comprise programming tools for generating application programs (Pages 9-13 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process. INSS is preprogrammed with the proper format required to display the tables as shown; therefore, INSS is programmed with predefined formats for the designated terms. The data from the tables is used to create a negotiations history and generate the graphs, thereby implying that INSS's predefined formats are utilized to generate the history storage and graphing computer programs);

[Claim 12] wherein the computer programs further comprise programming tools for automating product design and development (Page 8 -- The packaged product of an aircraft with a specified warranty period is designed and developed);

[Claim 13] wherein the computer programs further comprise computer programs for tracking and analyzing costs and performance data (Pages 9-12 -- A history of negotiated prices, or costs, and progress, or performance, of the negotiations process are analyzing and tracked);

[Claim 14] wherein the predefined formats further comprise documentation formats to be used during negotiation and development (Pages 9-13 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and comprise documentation formats for the negotiation process);

[Claim 15] wherein the dynamic contracts manager further comprises an access control system for limiting the number of users allowed to participate in the negotiation

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of the terms specifying the item to be developed (Page 6 -- In the disclosed example, INSS requires users to register and limits the negotiation to two parties).

[Claims 16-29]      Claims 16-29 recite limitations already addressed by the rejection of claims 2-15 above; therefore, the same rejection applies.

[Claims 30-43]      Claims 30-43 recite limitations already addressed by the rejection of claims 2-15 above; therefore, the same rejection applies.

[Claims 44-57]      Claims 44-57 recite limitations already addressed by the rejection of claims 2-15 above; therefore, the same rejection applies.

### ***Conclusion***

7.      **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

December 28, 2005